

THIS DISPOSTION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB 2/3/98

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Remington Products Company

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Serial No. 74/509,840

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Allen S. Lipson for Remington Products Company

Elizabeth A. Dunn, Trademark Examining Attorney, Law Office  
109 (Deborah S. Cohn, Managing Attorney)

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Before Hanak, Hohein and Hairston, Administrative Trademark  
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Remington Products Company (applicant) seeks  
registration of REMINGTON in typed capital letters for  
"computers, laptop computers, word processors, electronic  
learning devices; namely hand-held computers, audio  
products; namely video tape recorders, camcorders,  
televisions and telecommunications machines; namely,  
telephones and telephone answering machines." The intent-  
to-use application was filed on April 7, 1994.

In her first office action, the Examining Attorney refused registration pursuant to Section 2(e)(4) of the Lanham Trademark Act on the basis that applicant's mark REMINGTON "is primarily merely a surname." In support of her refusal, the Examining Attorney referenced the PHONEDISC U.S.A. database (1994 ed.) showing that out of over 76 million listings, there were approximately 1900 individuals with the surname REMINGTON. However, in that first office action, the Examining Attorney went on to note that the "applicant may register a surname under Trademark Act Section 2(f) ... by establishing acquired distinctiveness. The applicant may present any of the following to establish distinctiveness. (1) The applicant may rely on a claim of ownership of one or more prior registrations on the Principal Register for a mark which is the same as the mark in this application for the same or related goods...."

In response, applicant noted that its trademark REMINGTON is not the surname of any particular individual, and that its mark REMINGTON was in fact "coined." Thus, applicant contended that the foregoing prevents "the mark [REMINGTON] from being primarily merely a surname." In the alternative, applicant claimed the benefits of Section 2(f) as suggested by the Examining Attorney by referencing many of its existing registrations of REMINGTON.

In her second office action, the Examining Attorney maintained that REMINGTON was primarily merely a surname. With regard to applicant's 2(f) claim, the Examining Attorney acknowledged that "the applicant owns 23 current REMINGTON registrations" covering a very wide array of goods including in particular the following: calculating machines; facsimile machines and parts thereof; radios; and pens and pencils.

However, the Examining Attorney rejected applicant's section 2(f) claim stating that "none of these goods [covered by the existing REMINGTON registrations] are closely related to the computer products, videotape recorders, camcorders, televisions, telephones and telephone answering machines that are covered by the instant application."

When the refusal was made final, the applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

Considering first whether REMINGTON is primarily merely a surname, we find that this is a very close question. In deciding whether REMINGTON is primarily a surname, there are three objective factors to be considered. In re Benthin Management, 37 USPQ2d 1332 (TTAB 1995). One factor to be considered is whether REMINGTON has any "recognized meaning other than that of a surname." 37 USPQ2d at 1333. While

applicant claims that REMINGTON is "coined," by the same token, applicant has not provided any evidence suggesting that REMINGTON has any other meaning. Thus, this factor weighs in favor of finding that REMINGTON is primarily merely a surname.

A second factor to be considered is whether there is anyone connected with applicant who has the surname REMINGTON. Applicant has stated that REMINGTON is not the name of any particular individual. While this is not an explicit statement that there is no one by the name of REMINGTON associated with applicant, we find that it is an implicit statement, especially because the Examining Attorney never inquired further of applicant as to whether there was anyone associated with applicant whose name was REMINGTON. Thus, this second factor weighs in favor of finding that REMINGTON is not primarily merely a surname.

Finally, the third objective factor in determining whether REMINGTON is primarily merely a surname is "the degree of [its] rareness." 37 USPQ2d at 1333. While at first blush the existence of 1900 individuals with the surname REMINGTON would suggest that this surname is by no means rare, by the same token, it must be remembered that the database from which these 1900 individuals were located consists of over 76 million people. Hence, we find that while REMINGTON is by no means a decidedly rare surname, by

the same token, it is by no means a common surname. Thus, this third factor is neutral.

In summation, we find, as previously noted, that the question of whether REMINGTON is primarily merely a surname is an extremely close one. Under such circumstances, even a very modest showing pursuant to Section 2(f) would be sufficient to establish that REMINGTON has become something other than primarily merely a surname.

As previously noted, the Examining Attorney has acknowledged that there are 23 existing registrations of REMINGTON owned by applicant, one of which dates to 1939. While a number of these registrations cover goods which are in no way related to the goods for which applicant now seeks to register REMINGTON, some of the registrations cover goods which are clearly related to the goods of the present application. As noted before, these goods include calculating machines, which are clearly related to computers; radios, which are clearly related to televisions; and facsimile machines which are telecommunications machines and hence are clearly related to telephones and telephone answering machines. Moreover, neither Trademark Rule 2.41(b) nor case law supports the Examining Attorney's contention that the goods of the existing registrations must be "closely related" to the goods of the pending application. (Examining Attorney's brief page 9, emphasis

added). Trademark Rule 2.41 reads, in pertinent part, as follows: "In appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as prima facie evidence of distinctiveness." This Board allowed, pursuant to Section 2(f), registration of the surname LYTLE for "brochures, catalogs and bulletins" based on the fact that applicant owned an existing registration of the same mark for the services of "planning, preparation and production of technical publications." In re Lytle Engineering, 125 USPQ 308 (TTAB 1960). In so doing, the Board stated as follows: "Considering the obvious relationship between the services identified in applicant's registration and the goods for which it seeks registration herein, it is concluded that a prima facie showing of distinctiveness has been made." 125 USPQ at 309 (emphasis added). If anything, the aforementioned goods of applicant's prior registrations bear more of an "obvious relationship" to applicant's current goods than did the services and goods set forth in Lytle Engineering.

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Decision: The refusal to register is reversed.

E. W. Hanak

G. D. Hohein

P. T. Hairston  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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